

REMARKSRestriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claim 1), drawn to an isolated polypeptide.

Group II (claims 11, 31, 32, 34, and 36-43), drawn to an isolated antibody that binds to a polypeptide, a composition thereof, a method of preparing a polyclonal antibody, a polyclonal antibody, a composition thereof, a method of making a monoclonal antibody, a monoclonal antibody, and a composition thereof.

Group III (claim 12), drawn to an isolated polynucleotide.

Group IV (claim 29), drawn to a method of assessing the toxicity of a test compound.

Group V (claims 30, 33, and 35), drawn to a diagnostic test for a condition or disease associated with the expression of PROPHO or a method for diagnosing a condition or disease associated with the expression of PROPHO.

Group VI (claim 44), drawn to a method of detecting a polypeptide.

Group VII (claim 45), drawn to a method of purifying a polypeptide.

Applicants hereby elect, with traverse, to prosecute Group II, which includes and is drawn to claims 11, 31, 32, 34, and 36-43. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants also submit that the invention encompassed by Groups V, VI, and VII (claims 30, 33, 35, 44, and 45) are drawn to methods of use of the antibody of Group II, and should be examined together. These method claims recite a product (i.e., an antibody), which is of the same scope as the claimed antibodies being searched by the Examiner. Therefore, it would not be an undue burden on the Examiner to examine these method claims since the searches for the claimed antibodies and these method claims would substantially overlap.

Applicants also respectfully submit that there is minimal additional burden on the Examiner to examine claims 30, 33, 35, 44, and 45 in addition to the claims elected in the present application, particularly in view of the searches and examination which were already conducted with respect to the previously issued claims and the additional burden on Applicants to file, prosecute and maintain yet another application in this family, and respectfully request that the Examiner consider doing so.

Applicants note in addition that claims directed to the polypeptides of Group I and the polynucleotides of Group III, although of somewhat different scope, have already been examined and allowed in the parent and grandparent applications. Group IV (claim 29) is directed to a method of use of the polynucleotide of Group III, and could be examined together, without undue burden on the Examiner.

Additionally, the method claims of Groups V, VI, and VII are entitled to rejoinder upon allowance of a product claim per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of a product claim, for rejoinder of process claims covering the same scope of products. See also M.P.E.P. 821.04 as follows.

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. . . . The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. . . . However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of the entirety of Applicants' claims.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,
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